

Deposited on January 19, 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

STL11231

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on January 19, 2006Signature Diana C. AndersonTyped or printed name Diana C. Anderson

Application Number

10/629,373

Filed

July 29, 2003

First Named Inventor

Quock Ying Ng

Art Unit

2653

Examiner

Allen J. Heinz

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 38,794☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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1/19/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐*Total of 1 forms are submitted.

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PATENT
Dkt. STL11231

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Quock Ying Ng, Yiren Hong, JingShi Goh, Nirroot
Jierapipatanakul and Dijohni Chandra**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/629,373** Group Art: **2653**
Filed: **July 29, 2003** Examiner: **Allen J. Heinz**
For: **INTEGRATED FILTER SYSTEM FOR A DATA STORAGE DEVICE**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Please enter the following remarks as Applicant's basis for this Pre-Appeal Brief
Request for Review.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED HIS
ALLEGATION THAT THE RECITED FEATURES *EXTERNAL FLUID STREAM* AND
INTERNAL FLUID STREAM ARE UNDEFINED IN THE SPECIFICATION, WHICH IS
THE BASIS FOR THE OBJECTION TO THE SPECIFICATION

The Examiner broadly alleged without explanation or comment that these claim terms
are not defined in the specification. (Office Action of 10/19/2005, para. 1) Applicant has
rebutted that allegation (see Applicant's Response filed 12/19/2005), but the Examiner
maintained the objection without explanation or comment (see Advisory Action of
12/30/2005). Given the ordinary meaning of the language, and the extent to which it is
addressed by the specification (discussed more below), Applicant can only conclude that the
Examiner's objection must be based on the terms not being explicitly defined in the
specification. Such an objection has no basis in the law and is not an issue ripe for appeal.

The specification need not describe the invention *in haec verba*. That is, the
specification "need not describe the claimed subject matter in exactly the same terms as used
in the claims; it must simply indicate to persons skilled in the art that as of the filing date the

applicant had invented what is now claimed.” *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). See also *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002)(“[T]he failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.”). The test for sufficiency of support is whether the disclosure of the application reasonably conveys to the skilled artisan that the inventor had possession at that time of the later claimed matter. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). The Examiner is thus obligated to measure the support found in the specification according to the understanding of one of ordinary skill in the art. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed. Cir. 2003).

Because the Examiner has refused to discuss this issue after his conclusory allegation, Applicant is left not knowing whether it is the terms “internal” and “external,” or the term “fluid stream,” or perhaps all these terms, that the Examiner believes would be undefined to a skilled artisan reading the specification. In any event, Applicant now reiterates that the skilled artisan would actually find none of these terms to be undefined for at least the following reasons:

1. The specification discloses the data storage device 100 has a sealed enclosure that clearly distinguishes the “internal” space as being inside the sealed enclosure from the “external” space as being outside the sealed enclosure. (“internal” is used interchangeably with “confined”; see, for example, specification para. [0011] and para. [0047] cited in Applicant’s Response of 12/19/2005, pg. 7)

2. The embodiments of the present invention contemplate filtering contaminants that originate both internally, such as from out-gassing, and that originate externally, such as from a harsh environment. (see Applicant’s Response of 12/19/2005, pg. 7-8) The specification employs the terms “internal” (or “confined”) and “external” in relation to the source of contaminants thirty-one and fourteen times, respectively. (see Applicant’s Response of 12/19/2005, pg. 8)

3. The specification clearly defines the “fluid stream” that transports internal contaminants to the filter, or the “internal fluid stream,” as being that which is created by the

rotation of the disc 110 inside the enclosure. (see Applicant's Response of 12/19/2005, pg. 8, citing para. [0038-0042])

4. The specification clearly defines the "fluid stream" that transports external contaminants to the filter, or the "external fluid stream," as being that which is drawn into the diffusion path 154. (see Applicant's Response of 12/19/2005, ppg. 8-9, citing para. [0026-0030]; para. [0033-0037]; para. 0046-0047])

5. Therefore, Applicant reiterates the following: "The skilled artisan, having read the specification, would readily understand the internal fluid stream as being the portion of the outwardly spiraling flow generated by the spinning discs that passes through the recirculating filter. The skilled artisan would also readily understand the external fluid stream as being the flow passing through the breather diffusion path from the external environment into the internal environment of the data storage device enclosure." (Applicant's Response of 12/19/2005, pg. 10)

6. The Examiner's conclusory allegation without substantiation or even explanation is not the substance of a complete examination that closes the merits only after clearly defining issues appropriately for appeal. 37 CFR 1.104(a).

7. This case is not in condition for appeal due to the unresolved issue that the final rejection is clearly not proper and without basis because the Examiner's assertion is clearly erroneous the at the claim terms "external fluid stream" and "internal fluid stream"" are undefined by the specification. Applicant now prays for an objective review of the factual and legal deficiencies of this objection in order to withdraw the objection or alternatively make it ripe for appeal.

STEMMING FROM THE ERRONEOUS OBJECTION TO THE SPECIFICATION
ABOVE, IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED
THE SECTION 112 REJECTION OF CLAIMS 1-13 AND 21-27 FOR LACK OF
ENABLEMENT

The Examiner's objection to the specification discussed above is the basis for the enablement rejection of these claims. As discussed above, Applicant submits that the objection to the specification is erroneous as a matter of fact and as a matter of law, and that the specification clearly teaches the skilled artisan how to make and use the invention without undue experimentation. (see Applicant's Response of 12/19/2005, pg. 11).

Accordingly, the Examiner's conclusory allegation without substantiation or even explanation is not the substance of a complete examination that closes the merits only after clearly defining issues appropriately for appeal. 37 CFR 1.104(a). As such, this case is not in condition for appeal due to the unresolved issue that the final rejection is clearly not proper and without basis because the Examiner's assertion is clearly erroneous that the claim terms "external fluid stream" and "internal fluid stream" are undefined by the specification. Applicant now prays for an objective review of the factual and legal deficiencies of this rejection in order to withdraw the rejection of claims 1-13 and 21-27, or alternatively make it ripe for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A
PRIMA FACIE CASE OF ANTICIPATION FOR THE REJECTION OF CLAIM 20 FOR
MEANS FOR FILTERING

The Examiner has agreed that claim 20 comes under Section 112 paragraph six but has not construed the claim accordingly. Applicant repeatedly rebutted the rejection over Tuma '498 in terms of the structural differences that distinguish its disclosure as not being structurally equivalent under a proper Section 112 paragraph 6 construction. (see Applicant's Response of 8/8/2005, pg. 16; Applicant's Response of 12/19/2005, pg. 12-13) In response, the Examiner has erroneously stated that Applicant made no such distinguishing argument, and based the final rejection on an erroneous standard of "obviousness" rather than the proper legal standard in view of the disclosed structure, and equivalents thereof, that are capable of the identical recited function. (see Applicant's Response of 12/19/2005, pg. 12).

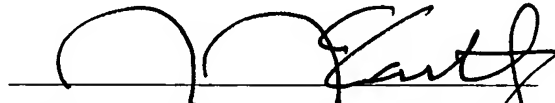
Accordingly, this case is not in condition for appeal due to the unresolved issue that the rejection is clearly not proper and without basis because the Examiner has failed to cite a reference that identically discloses all the recited features of the rejected claims, thereby failing to substantiate a prima facie case of anticipation. This case is also not in condition for appeal due to the unresolved legal issue that the rejection is clearly not proper and without basis because the Examiner has refused to construe claim 20 in accordance with Section 112 paragraph six. Applicant now prays for an objective review of the factual and legal deficiencies of this rejection in order to withdraw the rejection of claim 20 and the claims depending therefrom, or alternatively make it ripe for appeal.

Conclusion

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,

By: _____



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